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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,950	03/08/2005	Beak-Young Choi	J323-052 US	8001
21706	7590	06/23/2006	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			TRAN, CHUC	
			ART UNIT	PAPER NUMBER
			2821	

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/526,950	Applicant(s) CHOI ET AL.	
	Examiner Chuc D. Tran	Art Unit 2821	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A term “instead of the conventional method in which the COB is implanted” is an improper definition of a process, i.e., because it does not set forth any steps involved in the method/process.

3. Clarification is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, and 3-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Higuchi (USP. 6,600,219).

Regarding claim 1, Higuchi disclose a combination smart card (10) in Fig. 1, comprising:

an antenna terminal portion (111) so as to minimize an overlapped portion between the antenna terminal portion and a chip on board (100) for minimizing a capacitance value of the smart card of a combination type (Col. 6, Line 40-47) and (Col. 7, Line 43-52).

Regarding claim 3, Higuchi disclose that a width of a connection pad of the COB in a direction alone is 1.2mm or less (Col. 9, Line 2).

Regarding claim 4, Higuchi disclose a combination smart card in Fig. 1, comprising an antenna sheet layer (11), an intermediate sheet layer (21) and a printing sheet layer (31); the card body (10) using a laminating process (Col. 4, Line 25), the conventional method in which the COB (100) is implanted by means of a milling process (Fig. 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi in view of Giesler (USP. 6,424,029).

Regarding claim 2, Higuchi disclose a combination of a smart card as set forth in the claims except the antenna portion is soldered for electrical connection between the COB and the antenna terminal portion. Giesler disclose a smart card in Fig. 4 comprising the antenna portion 26 is soldered for electrical connection between the COB (1) and the antenna terminal portion (3) (Col. 5, Line 45); thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Higuchi by using soldering technical for connecting

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between the antenna terminal portion to the COB as taught by Giesler. The ordinary artisan would have been motivated to modify Higuchi in the manner described above for processing of manufacturing of the COB is simplified (See Giesler, Col. 3, Line 23).

Citation of relevant prior art

Prior art Sugimura (USP. 6,367,143) disclose coil element and method for manufacturing thereof.

Prior art Moskowitz et al (USP. 5,528,222) disclose radio frequency circuit and memory in thin flexible package.

Prior art Corniglion et al (USP. 6,132,799) disclose method for the manufacture of electronic cards.

Prior art Kuroda et al (USP. 6,585,165) disclose IC card having a mica capacitor.

Prior art de Vall (USP. 5,574,470) disclose radio frequency identification transponder apparatus and method.

Prior art Zakel et al (USP. 6,651,891) disclose method for producing contactless chip cards.

Prior art Emori et al (USP. 6,378,774) disclose IC module and smart card.

Inquiry

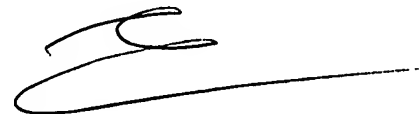
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuc D. Tran whose telephone number is (571) 272-1829. The examiner can normally be reached on M-F Flex hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy P. Callahan can be reached on (571) 272-1740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC
June 20, 2006



THO PHAN
PRIMARY EXAMINER